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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,884	01/23/2004	Rami Caspi	2003P13120US	6012

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Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
170 Wood Avenue South
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EXAMINER	
GAUTHIER, GERALD	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/763,884	CASPI ET AL.	
	Examiner	Art Unit	
	Gerald Gauthier	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15,17 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15,17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. **Claim(s) 1, 17 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. **Claim 1** recites the limitation "said first voicemail" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "said first voicemail" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "said first voicemail" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim(s) 2-14 are rejected for being dependent of rejected claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claim(s) 1, 4-6, 10-15, 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk (US 2004/0151284 A1) in view of Bijl et al. (US 6,173259 B1).

Regarding **claim(s) 1, 15 and 17**, Adamczyk discloses a method (FIG. 2 and paragraph 0002), comprising:

receiving a first voice mail message, said first voice mail message being associated with a recipient (FIG. 2 and paragraph 0066) [The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

converting said first voice mail message to a first instant message (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform]; and

determining an instant message address associated with said recipient (FIG. 2 and paragraph 0067) [The VMS 306 retrieves a corresponding address for an instant message user from an associated database].

Adamczyk discloses a voice mail message converted into an instant message but fails to disclose sending the first instant message and the first voice mail message to the address.

However, Bijl teaches sending said first instant message and said first voice mail message to an address (column).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the teaching of sending the voice message with an instant message as taught by Bijl.

This modification of the invention enables the system to send said first instant message and said first voice mail message to said address so that the user would retrieve the voice message and the text message and compare them for a better translation.

Regarding **claim(s) 4**, Adamczyk discloses a method, further comprising:

receiving a command from said recipient regarding said first voice mail message (FIG. 4 and paragraph 0075).

Regarding **claim(s) 5**, Adamczyk discloses a method, further comprising: receiving a command from said recipient regarding a second voice mail message (FIG. 4 and paragraph 0075).

Regarding **claim(s) 6**, Adamczyk discloses a method, further comprising: sending data indicative of a calling telephone number associated with said first voice mail message (FIG. 4 and paragraph 0077).

Regarding **claim(s) 10**, Adamczyk discloses a method, further comprising: receiving a second instant message, said second instant message being indicative of a request for information regarding at least one voice mail message associated with said recipient (FIG. 4 and paragraph 0077).

Regarding **claim(s) 11**, Adamczyk discloses a method, further comprising: receiving a second instant message, said second instant message including a text message (FIG. 4 and paragraph 0078).

Regarding **claim(s) 12**, Adamczyk discloses a method, further comprising: converting said second instant message into a second voice mail message (FIG. 4 and paragraph 0078).

Regarding **claim(s) 13**, Adamczyk discloses a method, further comprising: providing said second voice mail message to a party associated with said first voice mail message (FIG. 4 and paragraph 0078).

Regarding **claim(s) 14**, Adamczyk discloses a method, wherein said second instant message includes data indicative of a party and further comprising providing said second voice mail message to said party (FIG. 4 and paragraphs 0077-0078).

Regarding **claim(s) 18**, Adamczyk in combination with Bijl disclose all the limitations of **claim(s) 18** as stated in **claim(s) 1**'s rejection above and furthermore Adamczyk discloses a processor (Processor 306b on FIG. 2), a communication port (User Interface 306a on FIG. 2) and a storage device (hard drive of the computer based platform VMS 306 on FIG. 2).

8. **Claim(s) 2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Bijl as applied to **claim(s) 1** above, and further in view of Hanson et al. (US 6,697,474 B1).

Regarding **claim(s) 2**, Adamczyk in combination with Bijl as applied to **claim(s) 1** above differs from **claim(s) 2**, in that it fails to disclose determining if said recipient is available to receive an instant message.

However, Hanson, in the same field of endeavor, teaches a method, further comprising: determining if said recipient is available to receive an instant message (FIGS. 7-9 and column 8, lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Bijl using the automated call processor as taught by Hanson.

This modification of the invention enables the system to determine if said recipient is available to receive an instant message so that the user would receive a telephone call via its instant messaging client as a virtual second telephone line (Hanson: column 2, lines 1-6).

Regarding **claim(s) 3**, Hanson, in the same field of endeavor, teaches, wherein said sending said first instant message to said address occurs only after determining that said recipient is available to receive an instant message (FIGS. 7-9 and column 8, lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line to send the voice mail as an instant message].

9. **Claim(s) 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Bijl as applied to **claim(s) 1** above, and further in view of Agraharam et al. (US 6,654,448 B1).

Regarding **claim(s) 7**, Adamczyk in combination with Bijl as applied to **claim(s) 1** above differs from **claim(s) 7**, in that it fails to disclose sending data indicative of said first voice mail message's length of time.

However, Agraharam, in the same field of endeavor, teaches a method, further comprising: sending data indicative of said first voice mail message's length of time (FIG. 1 and column 6, lines 23-36) [The information is data that indicates the time required for transmitting the message].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Bijl using the network as taught by Agraharam.

This modification of the invention enables the system to send data indicative of said first voice mail message's length of time so that the system would charge the user for each message transmitted (Agraharam: column 6, lines 37-44).

Regarding **claim(s) 8**, Agraharam, in the same field of endeavor, teaches a method, further comprising: sending data indicative of a number of voice mail messages associated with said recipient (FIG. 1 and column 5, lines 23-36) [The information is data that indicates the cumulative number of documents transmitted].

10. **Claim(s) 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Bijl as applied to **claim(s) 1** above, and further in view of Groner (US 6,507,643 B1).

Regarding **claim(s) 9**, Adamczyk in combination with Bijl as applied to **claim(s) 1** above differs from **claim(s) 9**, in that it fails to disclose converting said first voice mail message to an email message, determining an email address associated with said recipient and sending said email message to said email address.

However, Groner, in the same field of endeavor, teaches a method, further comprising: converting said first voice mail message to an email message (FIG. 2 and column 4, line 65 to column 5 line 1) [The voice-to-electronic mail system 30 generates a text message file from the audio message from the caller, thereby converting the voice mail message to an email message];

determining an email address associated with said recipient (FIG. 2 and column 4, lines 62-65) [The voice-to-electronic mail system 30 determines an e-mail address in accordance with the recipient' s telephone number]; and

sending said email message to said email address (FIG. 2 and column 5, lines 2-4) [The voice-to-electronic mail system 30 sends a text message file at the recipient' s e-mail address].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Bijl using the voice-to-electronic mail system as taught by Groner.

This modification of the invention enables the system to convert said first voice mail message to an email message, determining an email address associated with said recipient and sending said email message to said email address so that the system would reduce the amount of data that is transmitted (Groner: column 3, lines 41-43).

Response to Arguments

11. Applicant's arguments with respect to **claim(s) 1-15, 17 and 18** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

GG
August 28, 2006